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V.S

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/304,523 05/04/99 YAMAZAKI

S 07977/046002

IM22/1027

EXAMINER

CHAMPAGNE, D

SCOTT C HARRIS  
FISH & RICHARDSON  
SUITE 1400  
4225 EXECUTIVE SQUARE  
LA JOLLA CA 92037

ART UNIT

PAPER NUMBER

1765

DATE MAILED: 10/27/99

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/304,523

Applicant(s)  
Yamazaki et al.

Examiner  
Donald L. Champagne

Group Art Unit  
1765



☒ Responsive to communication(s) filed on 4 June 1999

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three (3) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of

## Disposition of Claim

☒ Claim(s) 7-30 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 7-30 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirements

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. §

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☒ received.

☐ received in Application No. (Series Code/Serial Number)

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s).

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

**DETAILED ACTION**

***Claim Rejections - 35 U.S.C. § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 25-30 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a substrate and film with different coefficients of thermal expansion, or, equivalently, a substrate and film which have been deformed by heating, does not reasonably provide enablement for the substrate and film broadly defined in claims 25 and 28. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to perform the invention commensurate in scope with these claims.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 7-30 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

At the second line from the end of claims 7, 13, 19, 25 and 28, "roughness and waviness" is indefinite. Also, at the third line from the end of claims 10, 16 and 22, "a difference in level of the surface" is indefinite.

***Allowable Subject Matter***


5. Claims 7-30 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action, and, for dependent claims, to include all of the limitations of the base claim and any intervening claims.

6. The following is an examiner's statement of reasons for (tentative) allowance: The prior art does not teach or suggest sucking to flatten an insulating substrate with a semiconductor film deposited thereon. The prior art relies on layering to flatten the substrate with semiconductor film (Sugimoto *et al.*). Sucking to flatten a substrate is taught by the prior art (Aoyama), but only for a noninsulating substrate without a semiconductor film deposited thereon.
7. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L. Champagne whose telephone number is (703)308-3331.

DLC  
23 October 1999

  
BENJAMIN UTECH  
PRIMARY EXAMINER  
GROUP 1100